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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,694	04/19/2001	Tooru Matsumura	16869S-026400US	1786
20350	7590	05/20/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			TRAN, THAI Q	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/839,694

Applicant(s)

MATSUMURA ET AL.

Examiner

Thai Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/19/01, 8/14/03 & 6/14/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 7, 9-10, 12, 14-16, 21, 23-24, 26-28, 32, 34-35, and 37-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Oho et al (US 5,825,969).

Regarding claim 1, Ono et al discloses a digital signal recording/reproducing apparatus (Fig. 1(a)) for recording an inputted digital signal into a recording medium and reproducing said digital signal from said recording medium, a control flag (the number of executed reproducing cycles disclosed from col. 6, line 48 to col. 7, line 7) as to temporary copy permission being added to said inputted digital signal, comprising:

a recording circuit (VTR 3 disclosed in col. 6, lines 26-47) for recording said digital signal into a 1st recording medium,

a reproducing circuit (VTR 3 disclosed in col. 6, lines 26-47) for reproducing said digital signal from said 1st recording medium, and

a detecting/controlling circuit (the controller disclosed from col. 6, line 48 to col. 7, line 7) for detecting said control flag and controlling said recording circuit and said reproducing circuit, wherein

said detecting/controlling circuit temporarily records said digital signal into said 1st recording medium in accordance with a condition of said control flag, and reproduces said digital signal from said 1st recording medium in accordance with a condition of said control flag (controlling the VTR 3 disclosed from col. 6, line 48 to col. 7, line 7).

Regarding claim 2, Ono et al discloses the claimed wherein a new control flag is added to said inputted digital signal when said digital signal is recorded into said 1st recording medium, said digital signal being reproduced in accordance with a condition of said new control flag when said digital signal is reproduced from said 1st recording medium (the new reproduction repetition information disclosed from col. 6, line 64 to col. 7, line 7).

Regarding claim 7, Ono et al discloses the claimed wherein said control flag includes a reproducing frequency flag indicating information as to a frequency in which reproductions are permitted, said reproduction from said 1st recording medium being permitted if a present reproducing frequency is within said frequency indicated by said reproducing frequency flag (the repetition information disclosed from col. 6, line 64 to col. 7, line 7).

Regarding claim 9, Ono et al discloses the claimed wherein even if said control flag has copy information indicting copy prohibition, said control for recording said digital signal into said 1st recording medium is executed when a temporary copy flag has been

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detected, said temporary copy flag permitting a temporary recording into said 1st recording medium (the repetition information disclosed from col. 6, line 64 to col. 7, line 7).

Regarding claim 10, Ono et al discloses the claimed wherein even if said control flag has said copy information indicating said copy prohibition, said control for recording said digital signal into said 1st recording medium is executed when any one of a reproducing point-in-time flag, a reproducing time-period flag, a reproducing frequency flag, and a recording medium flag has been detected (the repetition information disclosed from col. 6, line 64 to col. 7, line 7).

Regarding claim 12, Ono et al discloses the claimed wherein said digital signal is erased if said reproducing frequency indicated by said reproducing frequency flag has been exceeded (erasing the information simultaneously with a reproducing operation or after the reproducing cycle has been repeated a predetermined number of times disclosed in col. 12, lines 45-53).

Regarding claim 14, Ono et al discloses a digital signal receiving apparatus (Fig. 1(a)) for receiving a transmitted digital signal and outputting said digital signal to a recording/reproducing apparatus, a control flag as to temporary copy permission being added to said received digital signal (the number of executed reproducing cycles disclosed from col. 6, line 48 to col. 7, line 7), comprising:

a detecting/controlling circuit (the controller disclosed from col. 6, line 48 to col. 7, line 7) for detecting said control flag and controlling said recording/reproducing apparatus, wherein in accordance with a condition of said control flag, said

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detecting/controlling circuit temporarily records said digital signal into a recording medium in said external recording/reproducing apparatus.

Regarding claim 15, Ono et al discloses the claimed wherein said detecting/controlling circuit executes a reproducing control of reproducing said digital signal from said recording medium in accordance with said condition of said control flag (controlling the VTR 3 disclosed from col. 6, line 48 to col. 7, line 7).

Regarding claim 16, Ono et al discloses the claimed wherein said detecting/controlling circuit adds a new control flag to said inputted digital signal when said digital signal is recorded into said recording medium, said detecting/controlling circuit reproducing said digital signal in accordance with a condition of said new control flag when said digital signal is reproduced from said recording medium (the new reproduction repetition information disclosed from col. 6, line 64 to col. 7, line 7).

Regarding claim 21, Ono et al discloses the claimed wherein said control flag includes a reproducing frequency flag indicating information as to a frequency in which reproductions are permitted, said detecting/controlling circuit permitted said reproduction from said recording medium if a present reproducing frequency is within said frequency indicated by said reproducing frequency flag (the repetition information disclosed from col. 6, line 64 to col. 7, line 7).

Regarding claim 23, Ono et al discloses the claimed wherein, even if said control flag has copy information indicating copy prohibition, when detecting a temporary copy flag permitting a temporary recording into said recording medium, said detecting/controlling circuit executes said control for recording said digital signal into

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said recording medium (the repetition information disclosed from col. 6, line 64 to col. 7, line 7).

Regarding claim 24, Ono et al discloses the claimed wherein, in accordance with said condition of said control flag, said detecting/controlling circuit erases said digital signal recorded into said recording medium (erasing the information simultaneously with a reproducing operation or after the reproducing cycle has been repeated a predetermined number of times disclosed in col. 12, lines 45-53).

Regarding claim 26, Ono et al discloses the claimed wherein said detecting/controlling circuit erases said digital signal when a present reproducing frequency has exceeded a predetermined frequency (erasing the information simultaneously with a reproducing operation or after the reproducing cycle has been repeated a predetermined number of times disclosed in col. 12, lines 45-53).

Method claims 27-28, 32, 34, 35, and 37 are rejected for the same reasons as discussed in apparatus claims 14-15, 21, 23-24, and 26 above, respectively.

Regarding claim 38, Ono et al discloses a digital signal recording/reproducing apparatus (Fig. 1(a)) for recording an inputted digital signal into a recording medium and reproducing said digital signal from said recording medium, a control flag (the number of executed reproducing cycles disclosed from col. 6, line 48 to col. 7, line 7) as to temporary copy permission being added to said inputted digital signal, comprising:

a recording circuit (VTR 3 disclosed in col. 6, lines 26-47) for recording said digital signal into a 1st recording medium,

a reproducing circuit (VTR 3 disclosed in col. 6, lines 26-47) for reproducing said digital signal from said 1st recording medium, and

a detecting/controlling circuit (the controller disclosed from col. 6, line 48 to col. 7, line 7) for detecting said control flag and controlling said recording circuit and said reproducing circuit, wherein

said detecting/controlling circuit temporarily records said digital signal into said 1st recording medium in accordance with a condition of said control flag (controlling the VTR 3 disclosed from col. 6, line 48 to col. 7, line 7).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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5. Claims 3, 13, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ono et al (US 5,825,969) in view of Sugiyama et al (US 6,894,860 B2).

Regarding claim 3, Ono et al discloses all the claimed limitations as discussed in claim 1 except for the claimed wherein said detecting/controlling circuit further records said digital signal into a 2nd recording medium in accordance with said condition of said control flag, said digital signal having been reproduced from said 1st recording medium.

Sugiyama et al teaches a dubbing system having protection information indicates whether dubbing is permitted or inhibited by the recording apparatus and is transmitted together with the AV data or DTV data (col. 3, lines 46-63).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the protective information as taught by Sugiyama et al into Ono et al's system in order to prevent the unauthorized users to copy the pre-recorded information.

Regarding claim 13, Sugiyama et al teaches the claimed wherein, when said control flag indicates that said digital signal cannot be recorded into said 1st recording medium, said digital signal is controlled so that said signal will not be recorded into said 2nd recording medium, either (copy permission information disclosed in col. 4, lines 17-34).

Claim 17 is rejected for the same reasons as discussed in claim 3 above.

6. Claims 4, 8, 18, 22, 29, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ono et al (US 5,825,969) in view of Ryota et al (EP 0 809 244 A2).

Regarding claim 4, Ono et al discloses all the claimed limitations except for providing the claimed wherein said control flag includes a recording medium flag indicating information as to a type of a recording into which a recording is permitted, said recording being permitted if said 1st recording medium is a recording medium specified by said recording medium flag.

Ryota et al teaches a software copying system having storage medium identifier recorded in the target storage medium allowing the recording medium to store the software (col. 4, line 46 to col. 5, line 9).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the storage medium identifier as taught by Ryota et al into Ono et al in order to prevent unauthorized users to copy the data.

Regarding claim 8, Ryota et al also discloses the claimed wherein said control flag includes a recording medium flag indicating information as to a type of a recording medium from which a reproduction is permitted, said reproducing being permitted if said 1st recording medium is a recording medium specified by said recording medium flag (col. 4, line 46 to col. 5, line 9).

Claim 18 is rejected for the same reasons as discussed in claim 4 above.

Claim 22 is rejected for the same reasons as discussed in claim 8 above.

Claim 29 is rejected for the same reasons as discussed in claim 4 above.

Claim 33 is rejected for the same reasons as discussed in claim 8 above.

7. Claims 5-6, 11, 19-20, 25, 30-31, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ono et al in view of Garfinkle (US 5,400,402).

Regarding claim 5, Ono et al discloses all the claimed limitations except for providing the claimed wherein said control flag includes a reproducing point-in-time flag indicating information as to a point-in-time when a reproduction is permitted, said reproduction from said 1st recording medium being permitted at a point-in-time that is earlier than said point-in-time indicated by said reproducing point-in-time flag.

Garfinkle teaches a system for limiting use of down-loaded video-on-demand data having instructions that specify and controls the number of times the stored data can be accessed or the period during which the stored material may be accessed or any combination thereof (col. 2, lines 18-37).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the instructions as taught by Garfinkle into Ono et al's system in order to simplify the process of limit the user of a program stored at a customer site commensurate with a fee.

Regarding claim 6, Garfinkle discloses the claims wherein said control flag includes a reproducing time-period flag indicating information as to a time-period during which a reproduction is permitted, said reproduction from said 1st recording medium being permitted at a point-in-time included within said time-period indicated by said reproducing time-period flag ((col. 2, lines 18-37).

Regarding claim 11, Garfinkle also discloses the claimed wherein said digital signal is erased when said time-period indicated by said reproducing time-period flag has passed (col. 2, lines 18-37).

Claim 19 is rejected for the same reasons as discussed in claim 5 above.

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Claim 20 is rejected for the same reasons as discussed in claim 6 above.

Claim 25 is rejected for the same reasons as discussed in claim 11 above.

Claim 30 is rejected for the same reasons as discussed in claim 5 above.

Claim 31 is rejected for the same reasons as discussed in claim 6 above.

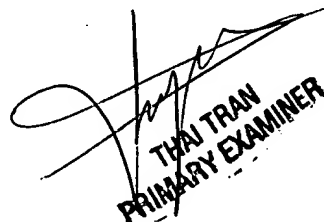
Claim 36 is rejected for the same reasons as discussed in claim 11 above.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (571) 272-7382. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTQ



THAI TRAN
PRIMARY EXAMINER